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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/444,254 11/22/99 BARNARD

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EXAMINER

TM02/0920

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HESS, D.

ART UNIT

PAPER NUMBER

2167  
DATE MAILED:

09/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/444,254

Applicant(s)  
Ray et al.

Examiner  
Douglas Hess

Art Unit  
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4-15 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Jul 23, 2001 is: ☒ approved ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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1. Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, lines 7-8, the step of analyzing “general human relations environment” appears to be vague and unsupported. The specification and drawings do not appear to mention this terminology let alone address this terminology or teach/support how “general human relations environment” can be quantified or analyzed via the applicant’s system.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 4-6, 8, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (US Patent 6,115,690) in view of Wewalaarachchi et al.

Because of the excessive volume (over 400 pages) of the Wong patent, only some of the drawings, the entire specification, and all of the claims have been included.

The method, software, and article of manufacture is each clearly disclosed in the Wong patent as currently claimed. See the attached marked up cover sheet of the Wong patent. Wong further teaches that legacy application modules are typically used in this environment (see Wong column 3, lines 52-53).

Wong fails to disclose the analyzing and adapting a legacy application to provide an adapted application customized to a specific customer. Wewalaarachchi et al. teaches a general human resource/supervisory control system and, in particular in claim 8, teaches receiving updated data from a legacy application which inherently would be customized to a particular object or person. The examiner equates getting updated data from a legacy application as taught by Wewalaarachchi et al. to analyzing and adapting a legacy application as claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the general system as taught by Wong and the manipulation of legacy application data as taught by Wewalaarachchi et al., furthermore, the manipulating of databases in a general procurement and accounts payable application is old and notorious (done by hand many years ago) and the combining of the step of updating a legacy application as taught by Wewalaarachchi et al. into this database manipulation of Wong does not provide a patentable

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departure from the device of Wong in view of Wewalaarachchi et al. The mere manipulation of data generally does not provide patentable subject matter without providing a specific well defined output.

5. Claims 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong in view of Wewalaarachchi et al. and further in view of Reilly.

Wong in view of Wewalaarachchi et al. discloses the network setup as claimed including the server, databases with templates, and web based users(as outlined in above paragraphs. Wong fails to fully disclose each method step in the procurement and accounts payable process. Reilly teaches that it is well known to perform many types of tasks in making a business model and Reilly's system 30 assists a user in building a model which can be customized to any degree desired using at least his Customized Client Model 48 with the aid of the Consultation tool 34. (See Reilly column 4.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of Wong with the tools as taught by Reilly, since well known claimed business activities such as assigning resources using a project implementation team, preparing a transition management team, performing analysis on human relations type activities, defining a quality assurance process, confirming that certain measuring factors can be met, and generating various strategy documents are well known to be done manually. It was known at the time of the

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invention that merely providing automatic means to replace manual activities which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91.

6. Applicant's arguments with respect to claims 4-15 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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9. Any inquiry concerning this communication should be directed to Doug Hess at telephone number (703) 308-3428.

Hess  
September 19, 2001

  
**DOUGLAS HESS**  
**PRIMARY EXAMINER**  
9-19-01